

5/19/04

Notice of Allowability

Application No.

09/839,577

Examiner

Robert Shiao

Applicant(s)

HAHN ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 06/29, 2004.
2. ☒ The allowed claim(s) is/are 84-90, now are 1-7.
3. ☒ The drawings filed on 20 April 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date <u>10/09, 2003</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

ETAILED ACTION

1. This application claims benefit of the provisional application: 60/218,113 with a filing date 7/13, 2000.
2. Applicant's request of correction of inventorship filed on June 29, 2004, is acknowledged. The inventors Rajeev Muthyala, Vadim Kraynov, Steven Bark, Dennis R. Burton, and Chester Chamberlain have been eliminated from the inventorship of the instant application.
3. Amendment of claims 84, 87-90, and cancellation of claims 1-83 and 91-92 in Paper No. 0604, dated June 29, 2004, is acknowledged. Claims 84-90 are pending in the application.

Responses to Amendment

4. Since the limitation of "charged group" and "reactive group" has been incorporated, therefore, the rejection of claims 84-90 under 35 U.S.C. 112, first paragraph, has been overcome in Paper No. 0604, dated June 29, 2004.
5. Since the limitation of variable R⁹ has been amended, i.e., at least one R⁹ is charged group or reactive group, therefore, the rejection of claims 84-90 under 35 U.S.C. 102(a, b) and 103(a) has been overcome in Paper No. 0604, dated June 29, 2004.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided

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by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robin A. Chadwick on August 30 30, 2004. The application has been amended as follows:

In claim 84, line 7, after "branched alkyl", delete "or heterocyclic ring derivatized" and **insert**

--substituted--

In claim 84, line 10, after "can be", delete "derivatized" and **insert**

--substituted—

In claim 84, line 12, after "one R⁹", insert

--is--

In claim 84, line 12, after "or at least one R⁹", insert

--is--

In claim 84, line 13, delete "derivatized" and **insert**

--substituted—

In claim 84, line 13, after "with a charged group", delete "is present on the compound"

In claim 84, page 3, line 4, after "hydroxylamine", delete "carboxylic acid activated by carbodiimide,"

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In claim 85, line 3, delete "derivatized" and **insert**

--substituted--

In claim 86, line 5, delete "derivatized" and **insert**

--substituted--

In claim 87, line 6, delete "derivatized" and **insert**

--substituted--

In claim 87, page 3, line 4, after "carboxylic acid", delete "carboxylic acid activated by carbodiimide,"

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

Claims 84-90 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to a labeled peptides, proteins and antibodies and processes and intermediates useful for their preparation. The closest prior art of record is Diehl et al. US 4,994,356, discloses solid particle dispersions of filter dyes for photographic elements. The difference between instant claims and Diehl et al. is that the variable R⁹ of instant claims do not represent carboxylic acid. (i.e., CO₂H). Suggestion for modification of prior art to obtain the instant compounds has not been found. Claims 84-90 are allowed.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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for Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

8/30/2004

R.S.

Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626

August 30, 2004